

RESPONSE UNDER 37 CFR 1.116
EXP. PROC.
EX. GRP 3641 #20

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3641



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

For: METHOD TO CONTROL REACTIONS
INVOLVING ISOTOPIC FUEL
WITHIN A MATERIAL USING
ORTHOGONAL ELECTRIC-FIELDS

Serial no. 09/ 748,691

Filed: 12/26/2000

This is a division of Serial no. 07/ 760,970

Filed: 09/17/1991

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MAY 02 2003

GROUP 3600

Group Art Unit: 3641

Examiner: Palabrica, R.J.

April 8, 2003

Commissioner for Patents
Washington, D.C. 20231

PETITION TO THE COMMISSIONER PURSUANT TO 37 C.F.R. 1.181

1. This Petition is made pursuant to 37 C.F.R. 1.181 to the Commissioner for Patents, and is made to invoke his supervisory authority to correct the situation with respect to the recent Office Communication [Exhibit "A" attached, mailed 4/15/03, and as described below]. Pursuant to 37 C.F.R. 1.181, there is no fee. This Petition is reasonable, based upon the reasons stated below and confirmed by the facts as discussed in the Declaration supporting this Petition.

2. In the discussion below, reference is made to the Declaration of Dr. Mitchell Swartz (hereinafter called the "Swartz Declaration") dated April 19, 2003. It will be demonstrated that this motion is reasonable because of Mr. Palabrica's now-repeated systematic failure to be accurate about "new material", and thus the presence of a non-uniform standard of review.

3. Attention of the Commissioner is directed to the fact that the Examiner inaccurately stated,

"New issues are amended claims 1, 5, 10 21, 22, 24, 26, and 28."

[Examiner Palabrica, Communication to Applicant, 4/15/03]

Applicant respectfully disputes this on a claim by claim basis. First, each and every change was made because the Examiner demanded it in his previous Communication (infra). Second, each and every change used material identical to the original specification and claims (infra). Third, the Applicant stated the above in the previous Communication. Fourth, each change will now be shown to be identical and exactly responding to what the Examiner suggested and/or demanded.

4. First, attention of the Commissioner is directed to claim 1. The words "heat" and "nuclear" were only added after the Examiner demanded it in his previous Communication, and they are --in fact-- exactly consistent with the Examiner's very own comment where he said what this invention involved. The entire original specification and claims involved heat and heat removal and the like.

THE EXAMINER'S DEMAND FOR THE CHANGE:

"Claims 1, 10 and 21 are vague, indefinite and incomplete as to what is actually the product. (Note this specific rejection that applied to previous claims 1-14 was not addressed in Applicant's response to the previous Office Action)."

[Examiner Palabrica, previous Communication to Applicant, 2/3/03]

To comply pursuant to the Examiner's demand, Claim 1 was amended in the Applicant's previous response of March 24, 2003, as follows:

1. (Amended) In a process for producing heat or a nuclear product using a material loaded with an isotopic fuel, a method to control the production of said product which includes in combination:
applying an electric field to load said isotopic fuel to said material,
loading said isotopic fuel into said material,
applying a second electric field in a non-parallel direction to the first applied electric fields,
producing redistribution of said isotopic fuel within said loaded metal,
thereby controlling the product produced.

The change was minor, was in response to the Examiner (supra), involved NO NEW MATERIAL and is consistent with Examiner's own statement in his previous Communication to Applicant dated 2/3/03.

THE EXAMINER'S STATEMENT PROVING THIS IS NOT NEW MATERIAL:

"In the current application the Applicant does not define the products of the claimed process and apparatus....the only possible "products" that can be formed in the claimed invention are nuclear fusion products. "

[Examiner Palabrica, previous Communication to Applicant, 2/3/03]

Therefore, given the Examiner's own statement (supra), and the original specification and claims containing this very material, and the entire previous docket with Examiner Wasil discussing this material, and the submitted Declarations discussing this material, truthfulness, and the normal standards of review, there is substantive evidence heralding that this is not new material. For the Examiner to call "heat" and "nuclear" products "new" i) AFTER HE DEMANDED IT and ii) when they are both in the original specification and claims, is --with all due respect-- disingenuous.

5. Next, attention of the Commissioner is directed to claim 5. The word "said" replaced the word "the" after the Examiner demanded it in his previous Communication.

THE EXAMINER'S DEMAND FOR THE CHANGE:

"Claims 5 and 22 recite The limitation "the group". There is insufficient antecedent basis for this limitation in the claims."

[Examiner Palabrica, previous Communication to Applicant, 2/3/03]

To comply pursuant to the Examiner's demand, Claim 5 was amended in the Applicant's previous response of March 24, 2003, as follows:

Claim 5 has been amended as follows:

5. (Amended) In a method as in claim 1, where said the isotopic fuel is a member of the group consisting of an isotope of hydrogen, boron, lithium, or potassium.

The change was minor, and was in response to the Examiner (supra), and involved NO NEW MATERIAL.

6. Next, attention of the Commissioner is directed to claim 10. The words "heat" and "nuclear" were only added after the Examiner demanded it in his previous Communication, and they are --in fact-- exactly consistent with the Examiner's very own comment where he said what this invention involved. The entire original specification and claims involved heat and heat removal and the like.

THE EXAMINER'S DEMAND FOR THE CHANGE:

"Claims 1, 16 and 21 are vague, indefinite and incomplete as to what is actually the product. (Note this specific rejection that applied to previous claims 1-14 was not addressed in Applicant's response to the previous Office Action).

[Examiner Palabrica, previous Communication to Applicant, 2/3/03]

To comply pursuant to the Examiner's demand, Claim 10 was amended in the Applicant's previous response of March 24, 2003, as follows:

10. (Amended) In a process for producing heat or a nuclear product using a material by a reaction, a method to control the redistribution of isotopic fuel loaded into said material which includes in combination:
applying an electric field to load said isotopic fuel into said material,
applying a second electric field to said material loaded with said isotopic fuel,
thereby effecting redistribution of said isotopic fuel.

The change was minor, was in response to the Examiner (supra), and involved NO NEW MATERIAL and is consistent with Examiner's own statement in his previous Communication to Applicant dated 2/3/03.

THE EXAMINER'S STATEMENT PROVING THIS IS NOT NEW MATERIAL

"In the current application the Applicant does not define the products of the claimed process and apparatus....the only possible "products" that can be formed in the claimed invention are nuclear fusion products. "

[Examiner Palabrica, previous Communication to Applicant, 2/3/03]

Therefore, given the Examiner's own statement (supra), and the original specification and claims consistent with this very material, and the entire previous docket with Examiner Wasil discussing this material, and the submitted Declarations discussing this material, honesty and the normal standards of review demand that this not be regarded as new material. For the Examiner to call "heat" and "nuclear" products new i) AFTER HE DEMANDED IT and ii) when they are both in the original specification and claims, is --with all due respect-- improper.

7. Next, attention of the Commissioner is directed to claim 21. The words "heat" and "nuclear" were only added after the Examiner demanded it in his previous Communication, and they are --in fact-- exactly consistent with the Examiner's very own comment where he said what this invention involved. The entire original specification and claims involved heat and heat removal and the like.

THE EXAMINER'S DEMAND FOR THE CHANGE:

"Claims 1, 16 and 21 are vague, indefinite and incomplete as to what is actually the product. (Note this specific rejection that applied to previous claims 1-14 was not addressed in Applicant's response to the previous Office Action).

[Examiner Palabrica, previous Communication to Applicant, 2/3/03]

The Examiner also demanded a clarification to show which of the recited steps produces the isotope redistribution.

THE EXAMINER'S DEMAND FOR THE CHANGE:

"Claim 21 recites in the ,preamble a method to effect redistribution of said isotope of hydrogen, whereas the body of the claim recites "thereby distributing said isotope of hydrogen within said loaded metal." It is unclear which of the recited steps produces the isotope redistribution."

[Examiner Palabrica, previous Communication to Applicant, 2/3/03]

To comply pursuant to the Examiner's demands, Claim 21 was amended in the Applicant's previous response of March 24, 2003, as follows:

Claim 21 has been amended as follows:

**21.(Amended) In a process for producing heat or a nuclear product using a metal loaded with an isotope of hydrogen, a method to effect redistribution of said isotope of hydrogen in said material which includes in combination:
applying an electric field to load said isotope of hydrogen into said metal,
loading said metal with said isotope of hydrogen,
thereafter applying a second electric field in a non-parallel direction to the first applied electric field, to thereby distributeing said isotope of hydrogen within said loaded metal.**

The change was minor, was in response to the Examiner (supra), involved NO NEW MATERIAL and is consistent with Examiner's own stateement in his previous Communication to Applicant dated 2/3/03.

THE EXAMINER'S STATEMENT PROVING THIS IS NOT NEW MATERIAL

"In the current application the Applicant does not define the products of the claimed process and apparatus....the only possible "products" that can be formed in the claimed invention are nuclear fusion products. "

[Examiner Palabrica, previous Communication to Applicant, 2/3/03]

Therefore, given the Examiner's own statement (supra), and the original specification and claims consistent with this very material, and the entire previous docket with Examiner Wasil discussing this material, and the submitted Declarations discussing this material, the normal standards of review demand that this not be regarded as new

material. For the Examiner to call "heat" and "nuclear" products new i) AFTER HE DEMANDED IT and ii) when they are both in the original specification and claims, is --with all due respect-- egregious.

8. Next, attention of the Commissioner, is directed to claim 22. The word "said" replaced the word "the" after the Examiner demanded it in his previous Communication.

THE EXAMINER'S DEMAND FOR THE CHANGE:

"Claims 5 and 22 recite The limitation 'the group'. There is insufficient antecedent basis for this limitation in the claims."

[Examiner Palabrica, previous Communication to Applicant, 2/3/03]

To comply pursuant to the Examiner's demand, Claim 22 was amended in the Applicant's previous response of March 24, 2003, as follows:

Claim 22 has been amended as follows:

22. (Amended) **In a method as in claim 21, where said loaded the material is a member of the group consisting of palladium, titanium, or nickel or their alloys.**

The change was minor, was in response to the Examiner (supra), involved NO NEW MATERIAL.

9. Next, attention of the Commissioner, is directed to claims 24, 26, and 28. The word "stopped by" replaced the word "impact" after the Examiner demanded it in his previous Communication.

THE EXAMINER'S DEMAND FOR THE CHANGE:

"New claims 24, 26 and 28 recite the limitation of 'having said redistribution of said isotopic fuel impact a barrier impermeable to said isotopic fuel.' There is neither a written description nor an enabling disclosure of: a) what exactly is meant by the term, 'impact'; by how and in what manner such redistribution causes the so-called impact a fuel-impenetrable barrier"

[Examiner Palabrica, previous Communication to Applicant, 2/3/03]

To comply pursuant to the Examiner's demand, Claims 24, 26, and 28 were amended in the Applicant's previous response of March 24, 2003, as follows:

24. (Amended) **In a method as in claim 21, where the additional step is taken of having said redistribution of said isotopic fuel stopped by impact a barrier impermeable to said isotopic fuel.**

Claim 26 has been amended as follows:

26. (Amended) In a method as in claim 1, where the additional step is taken of having said redistribution of said isotopic fuel stopped by impact a barrier impermeable to said isotopic fuel.

Claim 28 has been amended as follows:

28. (Amended) In a method as in claim 10, where the additional step is taken of having said redistribution of said isotopic fuel stopped by impact a barrier impermeable to said isotopic fuel.

The changes were minor, were in response to the Examiner (supra), and involved NO NEW MATERIAL. What does the Office want the Applicant to do? Such behavior by the Examiner, in the light of the Office failing to enforce standards of review and accountability, are probably not appropriate for the Office or any other Federal agency. To the contrary, assistance of, and help for, a citizen of the USA would be more appropriate.

10. On page 7 of the previous Communication from the Applicant to the Examiner, Applicant said,

"The applicant thanks the Examiner very much for these comments. Each of these are now corrected pursuant to the Examiner's comments."

There has been compliance by the Applicant.

On page 9 of the previous Communication from the Applicant to the Examiner, Applicant said,

"18. In summary, there IS definiteness because acceptability of the claim language depends on whether one of ordinary skill-in-the-art would understand what is claimed, and that is confirmed by the light of the specification, the Declarations, the Amicus Briefs, and the peer-reviewed publications [Ex parte Porter, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992)]. The Examiner has not responded to the fact that 35 U.S.C. 112, second paragraph requires the Examiner had to provide reasons why the terms in the claims and/or scope of the invention are unclear "in a positive and constructive way, so that minor problems can be identified and easily corrected, and so that the major effort is expended on more substantive issues."

There has not been compliance by the Examiner.

11. On pages 109-110 of the previous Communication from the Applicant to the Examiner, Applicant said,

"If this application is not allowed, and the Examiner continues to disagree with the numerous Affiants and peer-reviewed published papers, then the Applicant hereby formally requests explicitly that the Examiner respond in full with specificity as to the reason to facilitate Appeal, with the Examiner making clear on the record with precision which of these submitted averments by each Declarant regarding operability and utility were formally considered, and if the Examiner disputes them, exactly how he reached his conclusion, and why by substantive and adequate explanation how the Declarations failed to overcome the *prima facie* case initially established by the Examiner."

There has not been compliance by the Examiner.


12. The Amendments added no new matter.

The Examiner should explain his disingenuous statement that there is new matter, or should help the Applicant. This is because on page 109 of the previous Communication from the Applicant to the Examiner, Applicant said,

"If, for any reason the claims of this application are not believed to be in full condition for allowance, the applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims [pursuant to MPEP 707.07(j)] or in making constructive suggestions [pursuant to MPEP 706.03(d)] in order that this application can be placed in allowable condition as soon as possible and without the need for further proceedings. Applicant notes that the U.S. Supreme Court has ruled that any *pro se* litigant is entitled to less stringent standards [U.S. Rep volume 404, pages 520-521 (72)]. "

13. Mr. Palabrica's purported "new matter" were corrections added only after he suggested and/or demanded each specific change or amendment. The Applicant complied. The record proves this. The Applicant in good faith added the changes using matter from the original specification and claims, and submitted said amendments. They are NOT new material. The standards of review require the Examiner to explain precisely and substantively why the matter which is known to those skilled-in-the-art and consistent with *In re Jolles* (supra) and found in the original specification of the above-entitled application is "new matter". The Applicant requested this, but the Examiner did not comply. This is improper because the U.S. Supreme Court has ruled that any *pro se* litigant is entitled to less stringent standards [U.S. Rep volume 404, pages 520-521 (72)].

14. Wherefore, Applicant requests the Commissioner invoke his inherent supervisory power to correct this matter by directing the Examiner to state explicitly, substantively, precisely and completely what was "new matter" in the minor changes in Claims 1, 5, 10 21, 22, 24, 26, and 28 which were made in response to the Examiner's requests and which contained identical material to that within the original specification of the above-entitled application, or to simply direct the Examiner to work with the Applicant on this matter, as is just and reasonable.



Very respectfully submitted,

Mitchell R. Swartz, ScD, MD, EE
Post Office Box 81135
Wellesley Hills, Mass. 02481

Certificate Of Mailing [37 CFR 1.8(a)]

April 19, 2003

To Whom it Does Concern:

I hereby certify that this correspondence will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to "The Commissioner of Patents and Trademarks Washington, D.C. 20231" on the date below.

Thank you.

Sincerely,

April 19, 2003


M.R. Swartz



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,691	12/26/2000	Mitchell R. Swartz		4269

7590 04/15/2003
Mitchell R. Swartz, ScD, MD, EE
16 Pembroke Road
Weston, MA 02493

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GROUP 3600

EXAMINER

PALABRICA, RICARDO J.

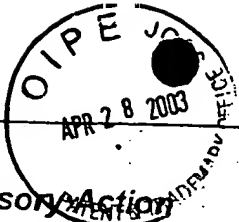
ART UNIT PAPER NUMBER

3641

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EXHIBIT "A"



Advisory Action

Application No. 09/748,691	Applicant(s) SWARTZ, MITCHELL R.
Examiner Rick Palabrica	Art Unit 3641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 28 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: New issues are amended claims 1, 5, 10, 21, 22, 24, 26 and 28.

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

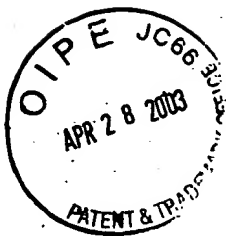
Claim(s) objected to: _____

Claim(s) rejected: 1, 5-8, 10-14, and 21-30.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

MAILED 04/01/03
SUPERVISOR



RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3641

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

For: METHOD TO CONTROL REACTIONS
INVOLVING ISOTOPIC FUEL
WITHIN A MATERIAL USING
ORTHOGONAL ELECTRIC-FIELDS

Serial no. 09/ 748,691

Filed: 12/26/2000

This is a division of Serial no. 07/ 760,970

Filed: 09/17/1991

Group Art Unit: 3641

Examiner: Palabrica, R.J.

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GROUP 3641

DECLARATION OF DR. MITCHELL SWARTZ

I, Mitchell R. Swartz, declare that I am a citizen of the United States of America and the inventor of the invention described in the above-entitled application.

1. I have a background in electrical engineering, material science, electrophysicist and electrochemistry and have worked in this field for more than a decade, and have worked on experimental projects at the Massachusetts Institute of Technology, Massachusetts General Hospital, and other locations going back to the late 1960's when I worked in MIT's Laboratory for Insulation Research, where barium titanate, a ferroelectric was made, and where samples of Apollo IX moon-rock were examined for their complex dielectric spectroscopic properties, from about 10^{-3} to 10^8 Hertz, back in 1969.

2. Mr. Palabrica purports that I added new matter in his Communication Of 4/15/03. I respectfully dispute this on a claim by claim basis. First, each and every change was made because the Examiner either suggested and/or demanded it in his previous Communication. Second, each and every change used material identical to the original specification and claims. Third, I stated the above in the previous

Communication. Fourth, each change will now be shown to be identical and exactly responding to what the Examiner demanded.

4. In Claim 1, 10, and 21 I responded to the Examiner, and added the words "heat" and "nuclear" as the Examiner explicitly requested and/or suggested and/or demanded in his previous Communication. The entire original specification and claims involved heat and heat removal and nuclear products and nuclear product removal. This was not new material.

5. In Claims 5 and 22, I responded to the Examiner, and the word "said" replaced the word "the". It is absurd to call this "new material" after the Examiner suggested and/or demanded it in his previous Communication.

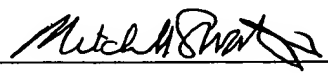
6. In Claims 24, 26, and 28, I responded to the Examiner, and the words "stopped by" replaced the word "impact" after the Examiner suggested and/or demanded it in his previous Communication.

7. The Amendments added no new matter.

I declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true.

Signature of Inventor:

April 19, 2003



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Post Office Box 81135
Wellesley Hills, Mass. 02481